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| EXAMINER |
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3625

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,970

Applicant(s)

BLANKENSHIP ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment filed March 28, 2005.

Claims 1-57 are pending and will be considered for examination.

Claim Objections

Claims 55-57 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are directed to computer-readable mediums having computer-executable instructions for performing the steps of claims 45, 48, and 50 respectively. These claims are improper because they fail the "infringement test" (see MPEP 608.01(n), Section III). Applying the Infringement test, what is needed to infringe claims 55-57 is, for example a CD-ROM having computer executable code that if and when executed would cause a computer to do the steps recited in claims 45, 48, and 50. However, such a CD-ROM would not infringe the method steps of claims 45, 48, and 50 since the CD-ROM itself never performs any of the active steps required by the method of claims 45, 48, and 50. In other words, mere possession of such a CD-ROM would infringe claims 55-57, but would not infringe claims 45, 48, and 50. As such claims 55-57 are improper dependent claims.

USC 112 Sixth Paragraph Notification

Applicants have provided means-plus function language in claim 37 which could be construed as having a narrower meaning emanating from specific embodiments found in the specification. Since it is the Applicants' responsibility to invoke USC 112 6th paragraph, the examiner will treat the claims using the broadest reasonable interpretation unless the Applicants respond to the office action invoking USC 112 6th paragraph and identifying the exact limitations that the Applicants are reading into the claims from the specification. Please be advised that should the Applicants invoke USC 112 6th paragraph in response to this office action the response may still be made final using the rationale that the Applicants have added new subject matter to the claims. A lack of response to this notice will be construed as prosecution history estoppel indicating that the Applicants does not wish to invoke USC 112 6th paragraph.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 37-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claim 38: This claim is directed to a "system" for managing welding consumables. The system has three parts: (1) a consumable monitor "component", (2) a customer "component", and (3) a supplier "component." The Applicants' specification defines a "component" as follows:

"A 'component' is a computer-related entity, either hardware, a combination of hardware and software, software, or software in execution. For example, a component may be, but is not limited being, a process running on a processor, a processor, an object, an executable, a thread of execution, a program and a computer. By way of illustration, both an application running on a server and the server can be components." (see page 5, lines 15-20).

Thus the Applicants' specification teaches that a "component" can be construed as a program (i.e. software). Therefore, the "system" of claim 38 comprises three programs. The Examiner notes that a program or software is nothing more than a series of instructions to perform an action (i.e. an algorithm) (see Microsoft Press Dictionary). Hence, the Applicants' "system" can be construed as comprising three algorithms. None of these "components" recite anything physical to constitute a "system" (i.e. an apparatus).

Referring to claims 37, 43, and 44: Claims 37, 43, and 44 are rejected under the same rationale as set forth above in claim 38.

Referring to claims 39-42: Claims 39-42 are dependent on claim 38. However, these claims fails to correct the deficiency of claim 38 and are rejected under the same rationale as set forth above in claim 38.

Referring to claim 45: For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present case, claim 45 recites receiving data via a "network." In its broadest reasonable interpretation a "network" can be construed as either a "computer network" or a "social network". A "social network" does not advance the technological arts because the operation being performed (i.e. receiving data) is not being performed by a computer or within a computer. On the other hand, if the term "network" is construed as a "computer network" then the step of receiving data via a "network" is

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deemed to be a nominal use of technology because the critical steps of “determining” and “ordering” can be performed manually and do not require any technology. For these reasons, claim 45 is directed to non-statutory subject matter.

Referring to claims 46 and 47: Claims 46 and 47 are dependent on claim 45.

However, these claims fails to correct the deficiency of claim 45 and are rejected under the same rationale as set forth above in claim 45.

Referring to claims 48-53: Claims 48-53 are rejected under the same rationale as set forth above in claim 45.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 37-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 38: Claim 38 is directed to a “system”. However, as noted above in the 101 analysis, Applicants’ invention can be construed as comprising three algorithms. It is unclear to the Examiner how three algorithms can constitute a “system” (i.e. apparatus) since an algorithm has no physical structure.

Referring to claims 37, 43, and 44: Claims 37, 43, and 44 are rejected under the same rationale as set forth above in claim 38.

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Referring to claims 39-42: Claims 39-42 are dependent on claim 38. However, these claims fails to correct the deficiency of claim 38 and are rejected under the same rationale as set forth above in claim 38.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9, 12, 15, 16, 21-23, 25-27, 32, 33, 35, 37, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett) in view of Dialog File 148 "Retrospective" (hereafter referred to as Dialog).

Referring to claim 1: Bennett discloses a system for managing welding consumables, comprising:

- a welder having a consumable monitor (Abstract: "The machine may be used to directly measure and compare costs of any welding processes by connecting it to various sensors which monitor the weld as it is produced."; page 342, lines 22-26: "...certain parameters such as welding current, arc voltage and wire usage rate are monitored by appropriate transducers and the signals relayed to an approved instrument box"; page 343, lines 40-46);
- a remote system that interfaces to the welder, the remote system facilities managing of welding consumables for the welder based at least in part upon information received from the consumable monitor (page 341, line 38 – page 342, line 1; page 342, lines 41-47; page 343, lines 36-46).

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Bennett does not expressly disclose that the remote system interfaces to the welder *via a network*. However, Bennett discloses that a transducer relays signals to an instrument box (page 342, lines 22-26). Furthermore, Dialog discloses remotely monitoring the quality of a weld via the Internet (page 1). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Dialog into the invention of Bennett. One of ordinary skill in the art would have been motivated to do so in order to remotely monitor the status of a weld as taught by Dialog.

Referring to claim 2: Bennett and Dialog teach or suggest all of the limitations of claim 1 as noted above. Furthermore, Bennett discloses that the remote system facilitates ordering and/or purchasing of a consumable based at least in part upon information received from the consumable monitor (page 341, line 38 – page 342, line 1). Bennett discloses that one of the benefits of his invention is to "...enable the welding engineer to present a clear case to purchasing department with regard to the purchase of say helium/argon mixtures..."

Referring to claim 3: The cited prior art teaches or suggests all of the limitations of claim 2 as noted above. Furthermore, Bennett discloses that the consumable is a wire and a gas (page 342, lines 22-26; page 343, lines 15-46).

Referring to claims 4, 5, and 9: The cited prior art teaches or suggests all of the limitations of claims 3 and 1 as noted above. The cited prior art does not teach the particular use of the consumables as noted in claims 4 and 5, or that the welder is leased to the customer as noted in claim 9. However, a recitation of the intended use of

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the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In the present case, the cited prior art is capable of performing the intended use of the consumables and lease agreement because the cited prior art has the same structure as the claim invention and because the prior art is directed to the same field of invention (i.e., monitoring a welder having consumables). Thus the limitations of claims 4, 5, and 9 do not patentably distinguish the structure of the claimed invention from the prior art.

Referring to claims 6-8: The cited prior art teaches or suggests all of the limitations of claim 2 as noted above. The cited prior art does not teach that the ordering and/or purchasing of the consumable is based on a customer ordering model, a vendor managed replenishment contract, or the nature of the ownership of the consumable. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The elements of the system would be the same regardless of any contract or ownership of the consumable. The differences between the Applicants' invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the

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prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have any contract or ownership model in the cited prior art because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of such information does not patentably distinguish the claimed invention.

Referring to claims 12 and 15: The cited prior art teaches or suggests all of the limitations of claim 1 as noted above. Furthermore, Dialog teaches that the network employs TCP/IP (page 1) and the Internet (page 1). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Dialog into the invention of Bennett. One of ordinary skill in the art would have been motivated to do so in order to remotely monitor the status of a weld via the Internet as taught by Dialog.

Referring to claim 16: The cited prior art teaches or suggests all of the limitations of claim 1 as noted above. Furthermore, Bennett teaches an arc quality monitor providing information regarding the weld quality to the remote system (page 342, lines 22-26).

Referring to claims 21-23, 25-27, 32, 33, 35 and 37: Claims 21-23, 25-27, 32, 33, 35, and 37 are rejected under the same rationale as set forth above in claims 1, 3-5, 12, 15, 16.

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Referring to claim 54: Claim 54 is rejected under the same rationale as set forth above in claim 1.

Claims 10, 11, 17-19, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett) in view of Dialog File 148 "Retrospective" (hereafter referred to as Dialog) and further in view of Tarr et al. (US 5,184,179) (hereafter referred to as Tarr).

Referring to claims 10 and 11: The cited prior art teaches or suggests all of the limitations of claim 1 as noted above. The cited prior art does not teach that the remote system enforces an agreement or contract or that the customer is invoiced by the system for consumables based on information received from the monitor. However, Tarr discloses a remote monitoring system (Figure 3, items "60" and "40") that that invoices a customer (Figure 1, item "36"; Figure 3, item "54") and provides service contract information (col. 3, lines 12-49). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Tarr into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow appropriate personnel to provide the appropriate service requirement and maintain accurate billing records as taught by Tarr (col. 3, lines 40-47).

Referring to claim 17: The cited prior art teaches or suggests all of the limitations of claim 1 as noted above. The cited prior art does not teach that a customer is invoiced by the system for consumables based on weld quality information received

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from the monitor. However, Tarr discloses a remote monitoring system (Figure 3, items "60" and "40") that that invoices a customer (Figure 1, item "36"; Figure 3, item "54").

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Tarr into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to maintain accurate billing records as taught by Tarr (col. 3, lines 40-47). Tarr does not teach that the invoice is based on weld quality. However, the Examiner notes that this limitation is not functionally or structurally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the recited system would be the same regardless of what information the invoice was based on. The difference between the content of the Applicants' invoice and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to base the invoice of the prior art on any information because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 18: The cited prior art teaches or suggests all of the limitations of claim 17 as noted above. Furthermore, Bennett discloses that the remote system

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tracks patterns of usage of welding consumables (page 342, lines 22-26; "...wire usage rate are monitored...")

Referring to claim 19: The cited prior art teaches or suggests all of the limitations of claim 17 as noted above. The cited prior art does not teach the particular use of the remote system as noted in claim 19. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In the present case, the cited prior art is capable of performing the intended use because the cited prior art has the same structure as the claim invention and because the prior art is directed to the same field of invention (i.e., monitoring a welder having consumables). Thus the limitation of claim 19 does not patentably distinguish the structure of the claimed invention from the prior art.

Referring to claim 36: Claim 36 is rejected under the same rationale as set forth above in claim 17.

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Claims 13, 14, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett) in view of Dialog File 148 "Retrospective" (hereafter referred to as Dialog) and further in view of Official Notice.

Referring to claim 13: The cited prior art teaches or suggests all of the limitations of claim 1 as noted above. The cited prior art does not teach that information is exchanged between the welder and the remote system using at least one of HTML, SHTML, VB Script, JAVA, CGI Script, dynamic HTML, ASP, ActiveX, XML, PDF, EDI, and WML format. However, Official Notice is taken that it is old and well known in the art to use HTML format to exchange information. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate HTML into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to present data in a user-friendly format.

Referring to claim 14: The cited prior art teaches or suggests all of the limitations of claim 1 as noted above. The cited prior art does not teach a LAN connection. However, Official Notice is taken that it is old and well known in the art to use a LAN connection to connect two or more devices. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a LAN connection in the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow two or more remote devices to communicate via a common network.

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Referring to claim 34: Claim 34 is rejected under the same rationale as set forth above in claim 13.

Claims 20 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett) in view of Dialog File 148 "Retrospective" (hereafter referred to as Dialog) and further in view of Sekizawa (US 6,681,349 B2).

Referring to claim 20: The cited prior art teaches or suggests all of the limitations of claim 1 as noted above. The cited prior art does not teach that the remote system performs resource or forecast planning. However, Sekizawa discloses a remote monitoring system that performs resource and forecast planning (col. 46, lines 15-40). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Sekizawa into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to set up a yearly plan of manufacturing for the consumables as taught by Sekizawa (col. 46, lines 35-40).

Referring to claims 28-31: Claims 28-31 are rejected under the same rationale as set forth above in claim 20.

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Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett) in view of Dialog File 148 "Retrospective" (hereafter referred to as Dialog) and further in view of Manchala et al. (US 6,405,178 B1) (hereafter referred to as Manchala).

Referring to claim 24: The cited prior art teaches or suggests all of the limitations of claim 22 as noted above. The cited prior art does not teach initiating an order based at least in part upon information received from the consumable monitor. However, Manchala discloses this limitation (col. 2, lines 31-53). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Manchala into the invention of Bennett. One of ordinary skill in the art would have been motivated to do so in order to take into account the changes in price of the consumable as taught by Manchala (col. 1, lines 16-20; col. 3, lines 15-25; col. 4, lines 47-59).

Claim 38 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett).

Referring to claim 38: Bennett discloses a system for managing welding consumables, comprising:

- a consumable monitor that monitors consumable usage and/or consumable status of a welder (Abstract: "The machine may be used to directly measure and compare costs of any welding processes by connecting it to

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various sensors which monitor the weld as it is produced.”; page 342, lines 22-26: “...certain parameters such as welding current, arc voltage and wire usage rate are monitored by appropriate transducers and the signals relayed to an approved instrument box”; page 343, lines 40-46);

- a component to facilitate welding resource management based at least in part upon information regarding consumable usage received from the consumable monitor component (page 341, line 38 – page 342, line 1; page 342, lines 41-47; page 343, lines 36-46);
- a component that receives information and facilitates purchasing of welding consumables (page 341, line 38 – page 342, line 1).

Bennett does not disclose that the second and third components are “customer” and “supplier” components respectively. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The elements of the recited system would be the same regardless of what names were given to the components. The difference between the Applicants’ invention and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to give the components in Bennett’s system any name because such information does not functionally or structurally relate to the elements of the claimed system and because the

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subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 40: The cited prior art teaches or suggests all of the limitations of claim 38 as noted above. Furthermore, Bennett discloses that the consumable is a wire and a gas (page 342, lines 22-26; page 343, lines 15-46).

Referring to claims 41 and 42: The cited prior art teaches or suggests all of the limitations of claim 40 as noted above. The cited prior art does not teach the particular use of the consumables as noted in claims 41 and 42. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In the present case, the cited prior art is capable of performing the intended use of the consumables because the cited prior art has the same structure as the claim invention and because the prior art is directed to the same field of invention (i.e., monitoring a welder having consumables). Thus the limitations of claims 41 and 42 do not patentably distinguish the structure of the claimed invention from the prior art.

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Claims 39, 43, 45, 46, 48-53, and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett) in view of Manchala et al. (US 6,405,178 B1) (hereafter referred to as Manchala).

Referring to claim 39: Bennett teaches or suggests all of the limitations of claim 38 as noted above. Bennett does not disclose at least one of a production control component, a financial accounting component and a materials management component. However, Manchala discloses this limitation (col. 3, lines 26-30). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Manchala into the system of Bennett. One of ordinary skill in the art would have been motivated to do so in order to automate the material handling process as taught by Manchala.

Referring to claim 43: Bennett discloses a system for managing welding consumables comprising:

- a consumable monitor component that monitors consumable usage of a welder (Abstract: "The machine may be used to directly measure and compare costs of any welding processes by connecting it to various sensors which monitor the weld as it is produced."; page 342, lines 22-26: "... certain parameters such as welding current, arc voltage and wire usage rate are monitored by appropriate transducers and the signals relayed to an approved instrument box"; page 343, lines 40-46);
- an aggregation component for aggregating consumable usage (page 342, lines 22-28);

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- a component that receives consumable information to facilitate purchasing of welding consumables (page 341, line 38 – page 342, line 1; page 342, lines 41-47; page 343, lines 36-46).

Bennett does not disclose that the component that facilitates purchasing is a “supplier” component. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the recited system would be the same regardless of the name given to the component. The difference between the Applicants’ invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to give the components in Bennett’s system any name because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention. Bennett does not disclose an inventory replenishment component that receives information from the aggregation component. However, Manchala teaches this limitation (col. 3, lines 26-30). Bennett does not disclose a procurement management component that determines whether to initiate reordering of the consumable based at least in part on inventory data and information associated with a vendor managed replenishment contract. However, Manchala

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discloses this limitation (col.3 lines 31-53; col. 4, lines 50-62). Bennett does not disclose a reorder proposal component for generating a reorder proposal once the procurement management component has initiated reordering of the consumable. However, Manchala discloses this limitation (col. 4, lines 26-34). Bennett does not disclose an authorization component that receives authorization for the reorder proposal received from the reorder proposal component. However, Manchala discloses this limitation (col. 4, lines 22-25, lines 62-66). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Manchala into the system of Bennett. One of ordinary skill in the art would have been motivated to do so in order to take into account the changes in price of the consumable as taught by Manchala (col. 1, lines 16-20; col. 3, lines 15-25; col. 4, lines 47-59).

Referring to claim 45: Bennett discloses a method for managing welding consumables comprising: receiving information from a consumables monitor regarding consumable usage of a welder (Abstract: "The machine may be used to directly measure and compare costs of any welding processes by connecting it to various sensors which monitor the weld as it is produced."; page 342, lines 22-26: "...certain parameters such as welding current, arc voltage and wire usage rate are monitored by appropriate transducers and the signals relayed to an approved instrument box"; page 343, lines 40-46). Bennett does not disclose that the information is received from a network. However, Manchala discloses this limitation (col. 2, lines 41-44). Bennett does not disclose determining whether supply of a consumable has fallen below ordering threshold. However, Manchala discloses this limitation (col. 3, lines 31-36; col. 4, lines 16-22). Bennett does not disclose ordering

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the consumable based at least in part upon the information received regarding the consumable usage. However, Manchala discloses this limitation (col. 2, lines 31-53). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Manchala into the invention of Bennett. One of ordinary skill in the art would have been motivated to do so in order to take into account the changes in price of the consumable as taught by Manchala (col. 1, lines 16-20; col. 3, lines 15-25; col. 4, lines 47-59).

Referring to claim 46: Bennett further discloses aggregating information regarding the consumable usage (page 342, lines 22-28).

Referring to claims 48-53: Claims 48-53 are rejected under the same rationale as set forth above in claims 43, 45, and 46.

Referring to claim 55: Bennett discloses a computer-readable medium having computer-executable instructions for executing at least a portion of the method of claim 45 (page 342, line 41 – page 345).

Referring to claims 56 and 57: Claims 56 and 57 are rejected under the same rationale as set forth above in claim 55.

Claim 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over B.J. Bennett "Using a microcomputer is costing and selling" (hereafter referred to as Bennett) in view of Manchala et al. (US 6,405,178 B1) (hereafter referred to as Manchala) in view of Official Notice.

Referring to claim 44: The cited prior art teaches or suggests all of the limitations of claim 43 as noted above. The cited prior art does not teach that the reorder is

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transmitted via EDI or XML. However, Official Notice is taken that it is old and well known in the art to use EDI to transmit and order. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to use a well-known communication system for placing an order.

Referring to claim 47: The cited prior art teaches or suggests all of the limitations of claim 45 as noted above. The cited prior art does not teach aggregating information regarding the consumable ordering. However, Official Notice is taken that it is old and well known in the art to aggregate orders. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to aggregate the orders in the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to negotiate a better price for the consumables through bulk ordering.

Response to Arguments

Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
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September 9, 2005